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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,002	10/11/2005	Yoon-Seok Hur	5413YSH-1	1279

22442 7590 04/03/2007
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EXAMINER

NASH, BRIAN D

ART UNIT	PAPER NUMBER
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3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/553,002

Applicant(s)

HUR, YOON-SEOK

Examiner

Brian Nash

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Examiner's Comments

1. This action is in response to applicant's amendment received 12/26/2006. The pending claims are now 1-19.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, the terminology "less than about 18 mm" is indefinite because there is no lower limit defined and the claimed stapler would not work if the length of the head section cover approached zero mm. It is suggested that applicant define a lower limit for the length. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 8-9 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,533,661 to Main et al. Insofar as the invention is claimed, Main et al shows the same circular stapler.

With respect to claims 1 and 12, a detachable anvil (100), a head section (60) having a head section cover (61), a cylindrical body (70) coupled to the head section, a recessed portion (decreased diameter section formed on the cylindrical body under the head section cover – see Fig. 1) that is capable of receiving an inner portion of an intestine or a circumferential length of tubular tissue.

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With respect to claim 2, the head section cover (61) has a circular plate shape (see Fig. 16).

With respect to claims 3-5, a cylindrical blade (69), a staple holder (68) having a plurality of slots (65), a push member (62) with a protruded portion (63), a support positioned under the push member and having a circular plate-shaped top (see Figs. 26-30 wherein Main et al shows an integral circular plate-shaped portion at the base of push member 62). The protruding portion (63) is formed thereon.

With respect to claim 8, the cylindrical body (70) has an arch shape (see Fig. 1).

With respect to claim 9, sections (64,72) are coupled and fixed to the recessed portion formed under the head section cover (61 – see Fig. 16).

With respect to claim 11, a trigger (86) provided at the lower end of the cylindrical body (70).

With respect to claims 13 and 14, the circular surgical stapler of Main et al is certainly capable of performing both end to end tubular anastomosis and end to side anastomosis (see column 1, lines 45-55).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-7, 10 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,533,661 to Main et al. As discussed above, Main et al shows the invention substantially as claimed.

With respect to claim 6, Main et al disclose the anvil shaft to be made of stainless steel, but do not explicitly disclose the other portions of the stapler, specifically the circular plate-shaped top of the support member, to be made of steel. It is well known in the art to use stainless steel when making surgical staplers and would have been obvious to one having ordinary skill in the art at the time the invention was made to configure/modify the circular head of the support member, which is integral to the

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push member, out of stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

With respect to claim 7, Main et al disclose the claimed invention except for the head section cover to be set to a length of 15-18 mm. It would have been an obvious matter of design choice to configure/modify the head section cover (61) since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

With respect to claim 10, Main et al disclose the claimed invention except for the shaft passing through the head section be set to a diameter of 1.0-1.5 mm. It would have been an obvious matter of design choice to configure/modify the shaft passing through the head section (104) since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

With respect to claims 15 and 17, Main et al shows a detachable anvil (100), a head section (60) having a head section cover (61), a cylindrical body (70) coupled to the head section, a recessed portion (decreased diameter section formed on the cylindrical body under the head section cover – see Fig. 1) that is capable of receiving an inner portion of an intestine or a circumferential length of tubular tissue; and a cylindrical blade (69), a staple holder (68) having a plurality of slots (65), a push member (62) with a protruded portion (63), a support positioned under the push member and having a circular plate-shaped top (see Figs. 26-30 wherein Main et al shows an integral circular plate-shaped portion at the base of push member 62), the protruding portion (63) is formed thereon. With respect to length of the head section cover being less than about 18mm (see rejection above under 35 U.S.C. 112, second paragraph) it would have been an obvious matter of design choice to configure/modify the head section cover (61) since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

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With respect to claim 16, sections (64,72) are coupled and fixed to the recessed portion formed under the head section cover (61 – see Fig. 16).

With respect to claims 18 and 19, the circular surgical stapler of Main et al is certainly capable of performing both end to end tubular anastomosis and end to side anastomosis (see column 1, lines 45-55).

Response to Arguments

8. *In re* claim 1, applicant's arguments filed 12/26/2006 have been fully considered but they are not persuasive. Applicant contends, *inter alia*, that Main et al does not perform the same function as the claimed invention, specifically that Main et al "does not disclose a recess for anastomosing two tubular tissue sections". Examiner acknowledges applicant's position; however, a reference is deemed to properly anticipate a claim when all the recited limitations are disclosed therein. In this instance, Main et al clearly shows all the recited structural limitations including a recessed portion in a side surface of the cylindrical body of the stapler that is capable of receiving an inner portion of intestine. While it is noted that the device of Main et al may not perform the same function or in the same manner as applicant's invention, it is deemed that the claims are not restrictive to such device. Specifically, claim 1 does not claim "a recess for anastomosing two tubular tissue sections".

For the reasons above, the grounds for rejection are deemed proper.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 6 p.m.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467. The official fax number for this Group is: 571-273-8300

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/28/2007



BRIAN D. NASH
PRIMARY EXAMINER
TECHNOLOGY CENTER 3700